



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

James E. Parker, President  
Vacutherm Inc.  
P.O. Box 305  
Warren, VT 05674

MAILED

OCT 13 2005

REEXAM UNIT

Dear Mr. Parker:

Thank you for your letter received August 15, 2005, in which you bring to the attention of John Doll, Commissioner for Patents, information about United States Patent (USP) 6,865,821 (the '821 patent). Your letter has been referred to me for consideration and response based on your concluding request "Please open a file for reexamination to determine how and why this discrepancy [between U.S. Patents 6,865,821 and 4,734,995] was overlooked" which has been interpreted as a request for a Director ordered reexamination. Your request has been interpreted in this manner as reexamination would be the most appropriate remedy, available through the United States Patent and Trademark Office, ("Office"), to address your present concerns and allegations regarding the '821 patent.

I. Request for Director Ordered Reexamination

The authority for the Director of the USPTO to order reexamination at his own initiative is provided for at 35 USC 303(a) (second sentence) which states:

"On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title."

However, the Director of the USPTO will not normally consider requests to order reexamination at the Director's initiative received from members of the public.<sup>1</sup> If a member of the public desires reexamination of a patent, a request accompanied by the appropriate fee should be filed in accordance with 37 CFR 1.510 for an *ex parte* reexam and 37 CFR 1.915 for an *inter partes* reexam.

Thus, if you feel that the '821 patent should not have been granted, you have the following options:

One procedure is to request an *ex parte* reexamination or an *inter partes* reexamination of the patent before the USPTO under the provisions of 35 U.S.C. 302 or 35 U.S.C. 311, respectively. Information on how to request a reexamination will be provided to you later in this letter. You should note, however, that reexamination proceedings are limited to prior art consisting of patents and printed publications. Thus for example, USP 4,734,995 to inventors Pagnozzi et al., and assigned to Vacutherm Inc., which you mentioned, could be submitted as part of a request for reexamination.

<sup>1</sup> Manual of Patent Examining Procedure, Eighth Edition, (August 2001, Rev. 2, May 2004), Sect. 2239.

Another procedure would be to question the validity of the patent in the Federal courts. Resort to the Federal courts would permit you to introduce patents and printed publications, and it would also permit you to introduce any evidence of prior use of the invention, as well as any other ground of unpatentability.

In the event you wish to exercise the option of filing in the U.S. Patent and Trademark Office a request for an *ex parte* reexamination or an *inter partes* reexamination of the '821 patent, I am enclosing copies of forms and materials which would assist you in preparing a request for reexamination of the patent. Enclosed are:

1. Form PTO/SB/57 REQUEST FOR EX PARTE REEXAMINATION TRANSMITTAL FORM: This form may be used as the cover sheet, or first pages, of a request for *ex parte* reexamination. It lists the formal requirements of an *ex parte* reexamination request. Each element should be addressed and completed and/or satisfied.
2. Form PTO/SB/58 REQUEST FOR INTER PARTES REEXAMINATION TRANSMITTAL FORM: This form may be used as the cover sheet, or first pages, of a request for *inter partes* reexamination. It lists the formal requirements of an *inter partes* reexamination request. Each element should be addressed and completed and/or satisfied.
3. Form PTO/SB/08a,b INFORMATION DISCLOSURE CITATION: This is the form used to list the patents and printed publication references upon which your request for reexamination is based. A copy of each reference should be submitted along with your request for reexamination.
4. The *ex parte* reexamination and *inter partes* reexamination statutes and the U.S. Patent and Trademark Office rules of practice relating to reexamination: The statute and rules control the conduct of any reexamination proceeding in the Office.
5. A photocopy of the web page providing access to the electronic version of the Manual of Patent Examining Procedure<sup>2</sup>- Notice is made particularly to Chapter 500 *Receipt and Handling of Mail and Papers*, Chapter 2200 *Citation of prior Art and Ex Parte Reexamination of Patents*, and Chapter 2600 *Optional Inter Partes Reexamination*, as they are useful in explaining how to submit the required materials.
6. A fee sheet: This is a copy of the page of the U.S. Patent and Trademark Office's filing-fee sheet showing the current \$2,520 *ex parte* reexamination filing fee under 37 CFR 1.20(c)(1) and the current \$8,800 *inter partes* reexamination filing fee under 37 CFR 1.20(c)(2). If your filing is delayed, you might wish to check with the USPTO to find out if the fee has changed. To check the most up to date fee schedule, visit <http://www.uspto.gov/main/howtofees.htm>

## II. 37 CFR 1.501 Citation of prior art in patent files

Please note that your letter is being forwarded to Technology Center 3700 Director, Richard A. Bertsch, for review, and handling of your citation of prior art pursuant to 37 CFR 1.501.

The following guidelines describe a portion of the protocol Technology Center 3700 will use for handling and consideration of your citation of prior art in the '821 patent file pursuant to 37 CFR 1.501:

---

<sup>2</sup> The Rev. 2, May 2004; this is the most recent revision.

1. Receipt of the prior art citation will be acknowledged by the TC Group Director in a letter mailed to the patent owner and to the sender (if different from the patent owner, and known). At that time, no determination will be made as to whether or not the citation is proper for entry into the patent file. Accordingly, the letter of acknowledgment will be limited to a notification that the prior art citation has been received, and will not contain any comments regarding the disposition of the citation. A copy of the letter of acknowledgment will be placed in the patent file and a "Contents" entry made to the file wrapper.<sup>3</sup>
2. After the mailing of the letter of acknowledgment, the TC Group Director will review the prior art citation to determine whether or not it is proper, i.e., whether or not it satisfies the requirements of the statute and the rules for entry into the patent file.

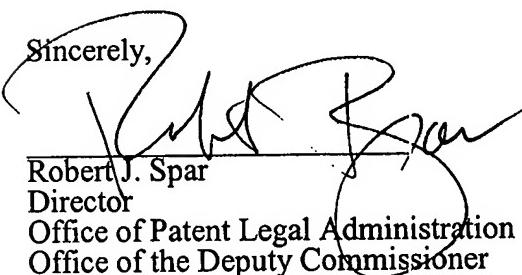
A prior art citation must not include any issue that is not directed to patents and printed publications, e.g., issues relating to 35 USC 112, public use, or the conduct of the patent owner. The citation must not discuss what the patent owner did, or failed to do, with respect to submitting and/or describing patents and printed publications. However, statements referring to the field of search conducted by the examiner (including statements directed to the failure to search a particular location) are permitted. See MPEP 2205 for a more detailed discussion of the guidelines that must be followed regarding the contents of a proper prior art citation submitted under 37 CFR 1.501.

### III. Conclusion

Thank you for bringing this matter to the attention of the U.S. Patent and Trademark Office. If you have further questions or inquiries about the present document, please contact either Elizabeth L. Dougherty at 571-272-7733 or Kenneth M. Schor at 571-272-7710, both Senior Legal Advisors, in the Office of Patent Legal Administration. Should you have any questions regarding your citation of prior art pursuant to 37 CFR 1.501, please contact SPRE Linda Sholl of Technology Center 3700 at 571-272-4391.

I hope you find the above information and the enclosed materials to be helpful.

Sincerely,



Robert J. Spar  
Director  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy

---

<sup>3</sup> The present letter serves as the "letter of acknowledgement" of your citation of prior art.